

In re Patent Application of:
JOHN A. MCMORRIS, III ET AL.
Serial No. **10/720,797**
Filing Date: **11/24/2003**

Remarks

Applicants and the undersigned would like to thank the Examiner for her efforts in the examination of this application. Claims 1-102 remain in the case.

Applicants take an interest and role in the review of the above referenced Office Action and comments presented by the Examiner. The Declaration herein presented under 37 CFR §1.132 by George D. Bolton, named co-inventor and Vice President of Assignee for instant application supports Applicants' view. Applicants, McMorris et al. are herein referred to as McMorris in attached exhibits for convenience. In addition, reference is herein made to Exhibits presented in the Bolton Declaration and incorporated into this Remarks section in the interest of clarity and avoiding unnecessary duplication.

I. Drawings

Trademarks AGCERT® and ENVIROCERT™ have been clearly identified in the specification and modified drawings of FIGS. 4A, 4B, 6, 11, 13, and 17 on replacement Drawings Sheets 4/21, 5/21, 7/21, 123/21, 16/21 and 20/21 respectively. No new matter is added by the modification of these drawings.

II. Claim Clarification

Dependent claims 17 and 90 have been amended to correct a grammatical error changing "form" to "forms" and properly meet the requirements of 35 USC §112, second paragraph to distinctly claim the subject matter Applicants regard as invention. No new matter is added by this amendment.

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III. Claims 1-102 are Patentable over Known Prior Art

Claims 1-18 and 20-102 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daggett et al. (US 2002/0173980 A1) (hereinafter "Daggett") in view of Sandor et al. (US 2005/0246190 A1) (hereafter "Sandor"). Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over Daggett in view of Sandor, and further in view of Mahosky et al. (US 2003/0101070 A1) (hereafter "Mahosky"). The Examiner's reasons for rejection as identified in Paragraphs 8-65 of the Office Action and Applicants' arguments are presented in the attached **Exhibit A**.

As illustrated in **Exhibit A**, while Sandor is cited in rejecting Claim 1-18 and 20-102, Sandor does not represent a proper prior art reference. However, it is currently understood that Sandor, a Continuation-In-Part application does claim priority to Provisional Patent Application S/N 60/397,401 (File date 7/20/02) through an intermediate parent application S/N 10/623,134 having filing date 7/18/2003 adding disclosure presented in Provisional Patent Application S/N 60/537,344 having filing date 1/15/2004. It would thus appear that Sandor has 7/20/2002 as the earliest Reference Date based Provisional Patent Application S/N 60/397,401. As addressed in the Bolton Declaration, a copy of the Sandor Provisional patent application appearing to represent a prior art reference is attached as **Exhibit B**.

With continued reference to Exhibit A, the instant application under consideration claims priority to Applicants' Provisional Patent Applications S/N 60/429,267 having filing date 11/26/2002 and S/N 60/440,069 having filing date 1/13/2003, both of these Priority Documents of the Applicants predate any other known Sandor reference. As further addressed in the Bolton Declaration, and as supported in the table of **Exhibit C**, Claims 1-102 are supported by the Applicants' Priority Documents, **Exhibit D** and **Exhibit E**. Yet further, and as addressed in the Bolton Declaration and in **Exhibit B**, the Sandor Provisional, appearing to be the prior art reference does not disclose nor

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suggest any step or combination of steps of the claimed invention.

Arguments herein presented with regard to Daggett, and with regard to Gaggett in view of Sandor are presented in table form in **Exhibit A**. By way of explanation, Column one makes reference to the paragraph in the Office Action, Column two reiterates comment made by the Examiner for a particular claim, and Column three includes the arguments supporting patentability of the claim.

It should be noted that the Examiner improperly relies on teachings in Sandor for Claims 2-4, 6, 21, 22, 24, 25, 27, 28, 31, 32, 37, 39, 42-44, 46, 48-53, 56, 59, 61-63, 65-67, 71, 73, 75, 77, 79, 81-84, 94, 97, 99 and 100. As above addressed, Sandor is not a proper reference and does not teach the subject matter addressed in these claims.

The office action does not appear to address Claim 85. However, Paragraph 58 of the office action is directed to Claims 53 and 63 addressing the limitation of Claim 85. The undersigned proceeds with an understanding that it was intended to have Claim 85 addressed in paragraph 58. In addition, the Examiner acknowledges Daggett does not teach modifying the environmental data to effective environmental data and makes reference to Page 5, Paragraph 67-68 and 71 which are not in Daggett. It is further understood that the Examiner intended to cite to Page 5, Paragraph 67-68 and 71 of Sandor in rejecting Claims 63, 63 and 85.

Detailed comments in response to the Examiner's rejections are presented in attached **Exhibit A** as technically supported by the Declaration of George D. Bolton and distinguished by the language of the claims. The claims are directed to a method of processing environmental emissions. Respectfully, the Examiner is reminded that the mere fact that a reference can be modified or references combined does not render the result obvious unless the prior art also suggests the desirable result. Further, modifying Daggett as suggested by the Examiner results in an unsatisfactory invention. There is no suggestion or motivation to make the modifications suggested by the Examiner.

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IV. Claims 19, 32, 47, 56, 60, 71, 80, 94 and 101 Comprise Patentable

Descriptive Material

Dependent Claim 19 adds the feature of documenting a non-conforming practice.

Claim 32, 56, 71 and 94 add the feature of allocating portions of effective environmental data to a reserve pool, mitigating delivery risk, or mitigate permanence risk. Claim 47, 60, 80 and 101 add the feature of identifying a point of sale event (airline ticket, fuel at pump, purchase of auto, etc.). These features further distinguish the claimed invention over known prior art by clearly describing practical operational aspects of the invention directed to a method of processing environmental emissions.

The Examiner has taken the position that the features described in the above referenced claims are non-functional descriptive data, and notes descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. The Examiner further indicates when presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. By way of example, the following case law is cited in support of the Examiner's position:

In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983);

In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994);

and

In re Ngai, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004).

The Examiner asserts the features presented in these claims add little, if

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anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) is also cited, but it appears MPEP 2106.01 is more appropriate with regard to "nonfunctional descriptive material" and relates to computer related subject matter and patentability. Respectfully, Applicants traverse Examiner's assertions.

By way of supporting arguments, In re Gulack is not applicable to the claimed invention. In re Gulack states differences between invention and prior art cited against it cannot be ignored merely because differences reside in content of printed matter. It goes on to say a "printed matter rejection" under Section 103 stands on questionable legal and logical footing. Standing alone, a description of an element of invention as printed matter tells nothing about differences between the invention and the prior art, or about whether that invention was suggested by prior art. It is interesting to note the rejection of claims as not directed to statutory subject matter was reversed.

In re Lowry is not applicable to the claimed invention. In re Lowry is directed to claims for data processing, storage, use and management of information. The claimed invention is not obligated to be a part of a computer or computer software.

In re Ngai addresses an addition of a new set of instructions into a known kit and states it is a new use for an old invention. It goes on to say since the addition of printed matter to existing product will not distinguish invention from prior art in terms of patentability if printed matter is not functionally related to product. This case is not an appropriate teaching for the claimed invention which includes interrelating steps and not simply the addition of printed matter.

Clearly, the features presented add yet additional limitations to the claimed invention and further distinguish the claimed invention over known prior art by describing practical operational aspects of the invention directed to a method of processing environmental emissions.

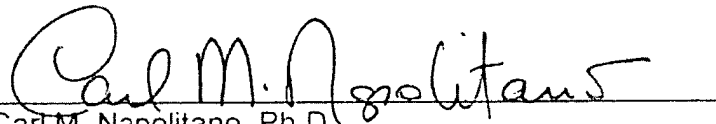
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V. Conclusion

Applicants respectfully submit that the above amendments, arguments and supporting material herein presented place this application in a condition for allowance, and passage to issue is respectfully solicited.

The Applicants and the undersigned would like to again thank the Examiner for her efforts and guidance provided in the examination of this application. If the further prosecution of the application can be facilitated through an interview between the Examiner and the undersigned, the Examiner is requested to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,



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